

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

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12 TECHNOLOGY LICENSING
13 CORPORATION, a Nevada NO. CIV. 2:03-1329 WBS PAN
Corporation,

14 Plaintiff, MEMORANDUM AND ORDER RE:
15 v. MOTION FOR CLAIM CONSTRUCTION
16 THOMSON, INC., a Delaware
17 Corporation,
Defendant.

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21 Technology Licensing Corporation ("TLC") owns U.S.
22 Patent Nos. RE40,411 E (the "'411" patent) and RE40,412 E (the
23 "'412" patent). The patents relate to identifying and separating
24 the synchronizing signal component of a video signal, which
25 allows televisions to accurately reproduce the image that was
26 transmitted to it over the airwaves. Plaintiff contends that
27 three of Thomson, Inc.'s ("Thomson") products violate plaintiff's
28 patents by incorporating three different sync separator chips

1 that practice plaintiff's patents. (Def. Thomson's Opening
2 Markman Brief Ex. E, at 4.)

3 On February 1, 2010 the parties submitted their claim
4 construction briefs and the court conducted a Markman¹ hearing on
5 March 1, 2010 on the limited issue of whether the terms "circuit"
6 and "circuitry" constitute means-plus-function limitations.
7 After considering the parties' briefs and all other relevant
8 documents, along with the parties' arguments at the Markman
9 hearing, the court construes the disputed claims as set forth
10 below.

11 I. Factual and Procedural Background

12 TLC is the holder of the '411 and '412 patents, which
13 are July 1, 2008 reissues of U.S. Patent Nos. 5,745,250 (the
14 "'250 patent"), and 5,486,869 (the "'869 patent"), respectively.
15 The '869 patent was issued from application No. 07/837,323, filed
16 on February 18, 1992. (Szpondowski Decl. Ex. B., at 1.) The
17 '250 patent was issued from a continuation-in-part application of
18 application No. 08/493,661, filed on June 22, 1995, which was a
19 continuation-in-part of application No. 07/837,323 which
20 eventually became the '869 patent. (Id. Ex. A., at 1.) The '411
21 patent comprises "a method and apparatus for identifying and
22 separating the synchronizing signal component of video like
23 signals by identifying or detecting the arrangement or sequence
24 of the known occurrences [sic] of events or patterns of the
25 synchronizing signal component" and the '412 patent "provides a
26 synchronizing signal separation." (Id. Ex. A, at 1, Ex. B, at

27
28 ¹ Markman v. Westview Instruments, Inc., 517 U.S. 370
(1996).

1 1.)

2 Images and sounds captured by television cameras are
3 transmitted to televisions via composite video signals, which
4 must then be accurately reproduced on the television screen. A
5 synchronization signal (also referred to as "sync signal" or
6 "sync pulse") within the composite video signal allows
7 televisions to accurately reproduce transmitted images by
8 indicating the beginning of the information for each line on the
9 television screen. The synchronization signal indicates this
10 information through changes in its voltage level, and the sync
11 signal must be extracted from the composite signal in order for
12 the television to accurately reproduce the transmitted image.

13 The '411 and '412 patents relate to identifying and
14 separating the sync signal component of a composite video signal
15 in order to allow accurate reproduction of the transmitted image.
16 A typical sync signal is a downward (negative) pulse that is
17 preceded by a "front porch" interval and followed by a "back
18 porch" interval. In order to identify and separate the sync
19 signal, the '411 and '412 patents outline two steps. First, the
20 "tip," or negative peak of the sync pulse (known as the "sync
21 tip"), is "clamped," or brought down to a known voltage level, by
22 adding current to or draining current from the signal. Second,
23 the clamped sync pulse is "sliced" by comparing it to a "slicing
24 voltage," which is typically found between the sync tip and the
25 "back porch" interval of the sync signal. The sync separator
26 produces a logic level sync signal that departs from its usual
27 level when the video signal is below the slicing voltage--that
28 is, when a sync pulse is present.

1 At issue in this litigation are three different sync
2 separator chips that Thomson incorporates into three of its
3 products: 1) the Elantec EL4583 chip in its LDK 5301 product; 2)
4 the Gennum 4882 chip in its FSS 8900 product; and 3) the Elantec
5 EL4511 chip in its 8900 GEN-SM product. (Def.'s Opening Markman
6 Brief Ex. E, at 4.) On June 20, 2003, TLC filed suit in this
7 court alleging that each of these products violate claims in the
8 '250 and '869 patents through incorporation of the three chips,
9 each of which practice the patents-in-suit. The action was twice
10 stayed pending resolution of a related case in the United States
11 District Court for the Northern District of California² and
12 pending completion of patent reissue proceedings for the '250 and
13 '869 patents on October 3, 2003, and September 20, 2004,
14 respectively. (Docket Nos. 24, 50.) On September 11, 2009,
15 Thomson filed an unopposed motion to lift the September 20, 2004
16 stay in the instant action, which was granted. (Docket Nos. 221,
17 225.) TLC filed a Second Amended Complaint on January 21, 2010
18 which substituted the '411 and '412 reissue patents for the '250
19 and '869 patents. (Docket No. 240.) Presently before the court
20 are the parties' motions for claim construction.

21 As submitted in their briefs, the parties agree on the
22 construction of two patent terms (Szpondowski Decl. Ex. C),
23 dispute the construction of forty terms (Id. Ex. D), and agree
24 that twenty-nine terms should be construed as having a plain and
25 ordinary meaning to one of skill in the art (Id. Ex. E). The
26 parties also dispute whether twenty-one claims in the '411 patent
27

28 ² Tech. Licensing Corp. v. Videotek, Inc., No. 01-4204.

1 containing the term "circuit" or "circuitry" constitute means-
2 plus-function limitations,³ and agree that several other terms in
3 the patents constitute means-plus-function limitations that
4 require identification of their function and structure (Id. Ex.
5 H).

6 **II. Discussion**

7 **A. Legal Standard**

8 The court, not the jury, must determine the meaning and
9 scope of patent terms. Markman v. Westview Instruments, Inc., 52
10 F.3d 967, 979 (Fed. Cir. 1995), aff'd., 517 U.S. 370, 372 (1996).
11 When construing disputed claim terms, the court often looks to
12 both intrinsic and extrinsic evidence. Vitronics Corp. v.
13 Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).

14 Intrinsic evidence includes the language of the claims,
15 specification, and prosecution history. Vitronics, 90 F.3d at
16 1582. The language of a patent's claims are "generally given
17 their ordinary and customary meaning," which is "the meaning that
18 the term would have to a person of ordinary skill in the art in
19 question . . . as of the [patent's] effective filing date."
20 Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).

21 "Importantly, the person of ordinary skill in the art is deemed
22 to read the claim term not only in the context of the particular
23 claim in which the disputed term appears, but in the context of
24

25 ³ While plaintiff's exhibit H also identifies two terms
26 in claims 35 and 36 of the '412 patent as a disputed "circuitry"
27 means-plus-function term, neither of the parties subsequently or
28 elsewhere mention these two terms as in dispute. Rather, the
parties repeatedly refer to the "circuit" or "circuitry" terms at
issue in the present litigation as being found in the '411
patent.

1 the entire patent, including the specification." Id.

2 The specification "is the single best guide to the
3 meaning of a disputed term." Vitronics, 90 F.3d at 1582. The
4 specification can provide further guidance on the meaning of
5 terms in the claims by, for example, (1) revealing a "special
6 definition given to a claim term by the patentee that differs
7 from the meaning it would otherwise possess," Phillips, 415 F.3d
8 at 1316, (2) revealing an "intentional disclaimer, or disavowal,
9 of claim scope by the inventor," id., or (3) defining a term by
10 implication, "such that the meaning may be found in or
11 ascertained by a reading of the patent documents," Novartis
12 Pharms. Corp. v. Abbott Labs., 375 F.3d 1328, 1334-35 (Fed. Cir.
13 2004). Limitations from the preferred embodiments or specific
14 examples in the specification, however, cannot be read into the
15 claim. Anchor Wall Sys. v. Rockwood Retaining Walls, Inc., 340
16 F.3d 1298, 1306 (Fed. Cir. 2003).

17 The patent's prosecution history "can often inform the
18 meaning of the claim language by demonstrating how the inventor
19 understood the invention and whether the inventor limited the
20 invention in the course of prosecution, making the claim scope
21 narrower than it would otherwise be." Phillips, 415 F.3d at
22 1317. The doctrine of prosecution disclaimer attaches only
23 "where the patentee has unequivocally disavowed a certain meaning
24 to obtain his patent," and will not attach where the alleged
25 disavowal of claim scope is ambiguous. Omega Engr., Inc. v.
26 Raytek Corp., 334 F.3d 1314, 1324, 1325 (Fed. Cir. 2003)

27 Extrinsic evidence "consists of all evidence external
28 to the patent and prosecution history, including expert and

1 inventor testimony, dictionaries, and learned treatises.”
2 Markman, 52 F.3d at 980. When used, extrinsic evidence cannot
3 “vary or contradict” claim language, Vitronics, 90 F.3d at 1584,
4 but it can be useful “for a variety of purposes, such as to
5 provide background . . . [and] to ensure that the court’s
6 understanding of the technical aspects of the patent is
7 consistent with that of a person of skill in the art, or to
8 establish that a particular term in the patent or the prior art
9 has a particular meaning in the pertinent field.” Phillips, 415
10 F.3d at 1318.

11 A patent claim or limitation can be expressed as a
12 “means . . . for performing a specified function without the
13 recital of structure, material or acts in support thereof.” 35
14 U.S.C. § 112(6). Claims expressed in this “means-plus-function”
15 format are “construed to cover the corresponding structure . . .
16 described in the specification and equivalents thereof.” Id.
17 Where a claim “recites a function, but then goes on to elaborate
18 sufficient structure . . . within the claim itself to perform
19 entirely the recited function, the claim is not in means-plus-
20 function format.” Sage Prods., Inc. v. Devon Indus., Inc., 126
21 F.3d 1420, 1427-28 (Fed. Cir. 1997).

22 Claims that do not use the word “means” enjoy a
23 rebuttable presumption that they are not in means-plus-function
24 format and that 35 U.S.C. § 112(6) does not apply. Watts v. XL
25 Sys. Inc., 232 F.3d 877, 877 (Fed. Cir. 2009). This presumption
26 can be rebutted when the term “nonetheless relies on functional
27 terms rather than the structure or material to describe
28 performance of the claimed function.” Micro Chem., Inc. v. Great

1 Plains Chem. Co., 194 F.3d 1250, 1257 (Fed. Cir. 1999).

2 Once it is established that a claim or limitation is in
3 means-plus-function format, courts interpret the claim in a two-
4 step process. First, the claimed function of the means-plus-
5 function claim or limitation must be identified. Next, the
6 structure for the "means" limitation must be defined. The
7 structure must be disclosed in the specification or prosecution
8 history, clearly linked to the stated function, and necessary to
9 perform that function. Omega Engr., 334 F.3d at 1321. The duty
10 to link structure in the specification to the recited function is
11 the trade-off in convenience for listing claims or limitations in
12 means-plus-function format.

13 B. Agreed Constructions

14 The parties agree to and the court will therefore adopt
15 the construction of the two terms in the '411 patent below:

16 1. Delayed version thereof (claims 9, 12, 13)

17 Delayed version of the marking signal.

18 2. Responsive to (claim 1)

19 A response that is dependent on that to which it is
20 responsive.

21 C. Terms the Parties Agree the Court Should Use the Plain
22 and Ordinary Meaning To One of Ordinary Skill in the
23 Relevant Art

24 The parties agree that twenty-nine terms should be
25 construed as having a plain and ordinary meaning to one of skill
26 in the art (Szpondowski Decl. Ex. E). The court will adopt the
27 parties' constructions in full.

28 D. The Meaning of "Circuitry"

1 Thomson argues that twenty-one uses of the words
2 "circuit" and "circuitry" in the '411 patent are means-plus-
3 function limitations. Because none of the terms use the word
4 "means," the parties agree that there is a rebuttable presumption
5 that the terms are not means-plus-function limitations and that
6 35 U.S.C. § 112(6) does not apply. Thomson presents two
7 arguments in favor of rebutting the presumption: first, that the
8 inventor of the patents unequivocally asserted during the patent
9 prosecution that the terms were means-plus-function in order to
10 overcome the prior art; and second, that it was previously
11 decided in Technology Licensing Corp. v. Gennum Corp., No. 01-
12 4204, 2007 U.S. Dist. LEXIS 35521 (N.D. Cal. May 4, 2007), that
13 "circuitry" is a means-plus-function limitation and TLC is thus
14 collaterally estopped from arguing otherwise. The court will
15 address each argument in turn.

16 1. Prosecution Disclaimer

17 In order for prosecution disclaimer to attach, the
18 alleged disavowing actions or statements must be "both clear and
19 unmistakable." Omega Engr., 334 F.3d at 1326. The statements
20 must be both "so clear as to show reasonable clarity and
21 deliberateness" and "so unmistakable as to be unambiguous
22 evidence of disclaimer." Id. at 1325 (citing cases). On June
23 10, 1994, inventor and applicant J. Carl Cooper responded to the
24 Patent Office's rejection of then pending Claims 29-33 of the
25 application that resulted in the '869 patent in view of the prior
26 art under 35 U.S.C. § 102. Cooper told the Patent Examiner:

27 Applicant wishes to call the examiner's attention to
28 the USPTO guidelines for interpreting Means or Step
plus Function limitations in claims, which was

1 published in the May 17, 1994 Official Gazette. It is
2 believed that this guideline is pertinent with respect
3 to the present objections. Specifically, the
4 examiner's [sic] would appear to be giving an overly
broad interpretation of the claim language when arguing
that the claims cover the cited prior art as discussed
below.

5 (Def.'s Opening Markman Brief Ex. D, at 15.) Claims 29-33 were
6 added to the patent application in a December 9, 1993 amendment,
7 and primarily comprise "circuitry responsive to" and "circuitry
8 for" various events and purposes. (See Szpondowski Decl. Ex. R.)
9 In his discussion of claims 29-33, Cooper repeatedly
10 distinguishes the claimed invention as "structurally and
11 functionally different" from the prior art, "which differences
12 are believed pertinent under the new examination guidelines."
13 (See Def.'s Opening Markman Brief Ex. D, at 17-18.)

14 Cooper later cancelled those claims in a June 16, 1995
15 amendment, (Szpondowski Decl. Ex. K, at 2), and they do not
16 appear in either the '250 or '869 patents. This is not, however,
17 dispositive of whether Cooper intended to broadly disclaim
18 "circuit" and "circuitry" as means-plus-function limitations.
19 See Adept, Inc. v. Murex Sec. Ltd., 539 F.3d 1354 (Fed. Cir.
20 2008). Because Cooper's response occurred before he filed the
21 continuation-in-part that resulted in the '250 patent, this
22 aspect of the prosecution history is shared by both the '250 and
23 '869 patents and may be relevant to construing both patents and
24 their reissues.

25 The seemingly broad language quoted above cannot be
26 said to clearly, unmistakably and unambiguously disclaim the term
27 "circuit" and "circuitry" as a means-plus-function limitation for
28

1 all such recitals currently at issue in the eventual '250 patent.
2 See Omega Engr., 334 F.3d at 1326. While the above language
3 seems to broadly argue for means-plus-function treatment of then-
4 claims 29-33 of the application that led to the '869 patent, the
5 court finds it telling that Thomson has no other evidence from
6 the prosecution history to support its position that Cooper
7 similarly intended to limit the claims at issue in the '250
8 patent. Cooper does not specifically refer to any term in claims
9 29-33 as a means-plus-function limitation, and Cooper does not
10 appear to assert that those terms are in means-plus-function
11 form. Similarly, Thompson provides no evidence from the
12 prosecution history that the patent examiner mentioned means-
13 plus-function limitations, § 112(6), or structures disclosed in
14 the specification that would be necessary to support means-plus-
15 function claims. Thomson certainly has not shown the court any
16 other evidence from the prosecution history that would show
17 either Cooper or the patent examiner considered the term
18 "circuitry" in the '250 patent to be subject to § 112(6).
19 Therefore the patent prosecution history will not suffice to
20 rebut the presumption that the terms are not in means-plus-
21 function form.

22 2. Collateral Estoppel

23 According to the doctrine of collateral estoppel or
24 issue preclusion, a judgment on the merits in a first suit
25 prevents relitigation of issues in a second suit if: 1) the issue
26 is identical to the one decided in the first action; 2) the issue
27 was actually litigated in the first action; 3) resolution of the
28 issue was essential to a final judgment in the first action; and

1 4) the party against whom estoppel is invoked had a full and fair
2 opportunity to litigate the issue in the first action. Innovad
3 Inc. v. Microsoft Corp., 260 F.3d 1326, 1334 (Fed. Cir. 2001).
4 "If there is doubt, however, collateral estoppel will not be
5 applied." Davis & Cox v. Summa Corp., 751 F.2d 1507, 1518 (9th
6 Cir. 1985). Even where the requirements for collateral estoppel
7 are met, the decision to apply the doctrine is within the court's
8 discretion. See id. at 1519.

9 In evaluating the application of collateral estoppel,
10 courts may refer to the Restatement (Second) of Judgments.
11 Foster v. Hallco Manuf. Co., Inc., 947 F.2d 469, 480 (Fed. Cir.
12 1991); Kamilche Co. v. United States, 53 F.3d 1059, 1062 (9th
13 Cir. 1995). The Restatement identifies four factors to be
14 considered in determining whether an issue in a successive
15 proceeding is identical to an issue previously litigated: (1) is
16 there a substantial overlap between the evidence or argument to
17 be advanced in the second proceeding and that advanced in the
18 first; (2) does the new evidence or argument involve the
19 application of the same rule of law as that involved in the prior
20 proceeding; (3) could the pretrial preparation and discovery
21 related to the matter presented in the first action reasonably be
22 expected to have embraced the matter sought to be presented in
23 the second; and (4) how closely related are the claims involved
24 in the two proceedings. Kamilche, 53 F.3d at 1062; see Applied
25 Med. Res. Corp. v. U.S. Surgical Corp., 352 F. Supp. 2d 1119,
26 1124-25 (C.D. Cal. 2005).

27 TLC's infringement suit against Thomson is based in
28 part on Thomson's use of the Gennum 4882 chip in its FSS 8900

1 product. In Technology Licensing Corp. v. Gennum Corp., No. 01-
2 4204, 2007 U.S. Dist. LEXIS 35521 (N.D. Cal. May 4, 2007) (the
3 "Gennum Litigation"), TLC sued Gennum for violating patents
4 including the '250 and '869 patents through, inter alia, the
5 Gennum 4882 chip. In a November 14, 2002 Order, Judge Breyer
6 construed the term "circuit" and "circuitry" as used eleven times
7 in three patents owned by TLC--including eight "circuitry" terms
8 in claims 27 and 31 of the '869 patent--as means-plus-function
9 limitations, Tech. Licensing Corp. v. Videotek, Inc., No. 01-
10 4204, (N.D. Cal. Nov. 14, 2002) (Docket No. 158), which TLC did
11 not challenge on appeal, Tech. Licensing Corp. v. Videotek, Inc.
12 & Gennum Corp., 545 F.3d 1316, 1338 (Fed. Cir. 2008). As one of
13 Gennum's customers, Thomson is in privity with Gennum for
14 preclusion purposes. Schnitger v. Canoga Electronics Corp., 412
15 F.2d 628 (9th Cir. 1972).

16 At issue in this litigation is whether the terms
17 "circuit" and "circuitry" as used in the '411 reissue patent of
18 the '250 patent are means-plus-function limitations. The Gennum
19 Litigation did not address whether any "circuit" or "circuitry"
20 terms in the '250 patent were means-plus-function limitations,
21 and the construction of claims 27 and 31 of the '869 patent is
22 not at issue in the present suit. The issue before this court,
23 however, is identical to the issue that was decided by Judge
24 Breyer. The argument that TLC and Thomson present to this court
25 is also identical to the arguments presented to Judge Breyer:
26 whether the terms "circuit" and "circuitry" by themselves
27 disclose sufficient structure such that they may avoid § 112 (6)
28 treatment. While the case law of the Federal Circuit has changed

1 since Judge Breyer's 2002 claim construction ruling, the rule of
2 law to be applied by the court in this case is the same as when
3 it was applied by Judge Breyer.

4 Separate patents describe "separate and distinct
5 [inventions]," 35 U.S.C. § 121, such that "it can not be presumed
6 that related patents rise and fall together." Comair Rotron, Inc. v. Nippon Densan Corp., 49 F.3d 1535, 1539 (Fed. Cir. 1999).
7 Yet as to the third and fourth factors articulated by the
8 Restatement (Second) of Judgments, the court finds that the '869
9 and '250 patents are so closely related that TLC could have
10 anticipated that Judge Breyer's construction of the term
11 "circuitry" in the Gennum Litigation could apply to future suits
12 on both the '250 and '869 patents or their reissues. "[T]he same
13 terms appearing in different portions of the claims should be
14 given the same meaning unless it is clear from the specification
15 and prosecution history that the terms have different meanings at
16 different portions of the claims." Fin Control Sys. Pty, Ltd. v. OAM, Inc., 265 F.3d 1311, 1318 (Fed. Cir. 2001). While this
17 principle is typically applied to claims occurring within the
18 same patent, it applies with equal force to identical terms
19 appearing in related patents. See Epcon Gas Sys. Inc. v. Bauer Compressors, Inc., 279 F.3d 1022, 1031 (Fed. Cir. 2002) ("The
20 same term or phrase should be interpreted consistently where it
21 appears in claims of common ancestry.") The '869 and '250
22 patents share a common file and prosecution history and use the
23 terms "circuit" and "circuitry" in an identical manner. The
24 court therefore finds that the issue is identical to that
25 previously decided by Judge Breyer.

1 The court finds that the other elements necessary for
2 collateral estoppel to apply are also met. The parties to the
3 Gennum Litigation fully briefed the issue of whether claims 27
4 and 31 of the '869 patent described "circuit" in means-plus-
5 function format, and Judge Breyer issued a claim construction
6 order that decided the issue. See Tech. Licensing Corp. v.
7 Videotek, Inc., No. 01-4204, (N.D. Cal. Nov. 14, 2002) (Docket
8 No. 158). Judge Seeborg relied on the claim construction that
9 claims 27 and 31 of the '869 patent were means-plus-function
10 limitations when he determined that the Gennum chip did not
11 infringe the '869 patent. Tech. Licensing Corp. v. Gennum Corp.,
12 No. 01-4204, 2007 U.S. Dist. LEXIS 35521, at *12-14. TLC had the
13 opportunity to appeal the claim construction ruling to the
14 federal circuit, but did not. All of the elements of collateral
15 estoppel are therefore present.

16 TLC also argues that the prior claim construction order
17 should not be binding on the court because of several intervening
18 Federal Circuit cases that have clarified that "the term
19 'circuit,' combined with a description of the function of the
20 circuit connote[s] sufficient structure . . . to avoid § 112 ¶ 6
21 treatment." Mass Inst. of Tech. v. Abacus Software, 462 F.3d
22 1344, 1355 (Fed. Cir. 2006) (also stating that "the term
23 'circuitry,' by itself, connotes structure"); Linear Tech. Corp.
24 v. Impala Linear Corp., 379 F.3d 1311, 1320 (Fed. Cir. 2004)
25 ("[W]hen the structure-connecting term 'circuit' is coupled with
26 a description of the circuit's operation, sufficient structural
27 meaning generally will be conveyed to persons of ordinary skill
28 in the art, and § 112(6) presumptively will not apply."); Apex

1 Inc. v. Raritan Computer, Inc., 325 F.3d 1364, 1373 (Fed. Cir.
2 2003) ("The term 'circuit' with an appropriate identifier such as
3 'interface,' 'programming' and 'logic,' certainly identifies some
4 structural meaning").

5 Yet all of those cases were decided before Judge
6 Seeborg issued his infringement decision and before TLC appealed
7 the Northern District infringement decision to the Federal
8 Circuit. TLC thus had ample opportunity to argue before either
9 court that Judge Breyer's prior claim construction order
10 incorrectly ruled that "circuit" was a means-plus-function
11 limitation. Collateral estoppel will therefore apply and the
12 court finds that the terms "circuit" and "circuitry" identified
13 by the parties in the '411 and '412 patents constitute means-
14 plus-function limitations.

15 E. Structures and Functions Related to "Circuitry"

16 Having determined that the terms "circuit" and
17 "circuitry" at issue in the '411 reissue patent are means-plus-
18 function limitations, the court must ascertain the claimed
19 functions and their corresponding structures. See Cardiac
20 Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1113
21 (Fed. Cir. 2002). A corresponding structure must be clearly
22 linked to the claimed function, B. Braun Med., Inc. v. Abbott
23 Labs., 124 F.3d 1419, 1424-25 (Fed. Cir. 1997), otherwise "the
24 applicant has in effect failed to particularly point out and
25 distinctly claim the invention as required by the second
26 paragraph of section 112." Tech. Licensing Corp. v. Videotek,
27 Inc., 545 F.3d at 1338 (quoting In Re Donaldson Co., 16 F.3d
28 1189, 1195 (Fed. Cir. 1994) (en banc)). The court determines

1 whether adequate structure is disclosed from the perspective of
2 one skilled in the art. See Intel Corp. v. VIA Techs., Inc., 319
3 F.3d 1357, 1356-66 (Fed. Cir. 2003).

4 Due to the complex and highly technical nature of the
5 '411 and '412 patents, the court believes that appointment of a
6 special master pursuant to Federal Rule of Civil Procedure 53
7 would be helpful and appropriate to assist the court in
8 construing all means-plus-function claims at issue in the '411
9 and '412 patents.

10 III. Appointment of a Special Master

11 After having considered the fairness of imposing the
12 likely expenses on, consulted with, and obtained the consent of
13 the parties, the court will therefore appoint a special master
14 pursuant to Federal Rule of Civil Procedure 53 to assist the
15 court in construing the remaining patent terms at issue.

16 A. Appointment

17 Within thirty days from the date of this Order, the
18 parties shall submit a statement indicating whom they have
19 jointly agreed to serve as special master, and that person
20 shall file within the same period an affidavit with the court
21 pursuant to Rule 53(b)(3)(A). If the parties cannot agree on a
22 special master, the parties shall submit a joint statement
23 listing up to three of each party's preferred persons to serve as
24 special master. The court will then select the special master
25 from among those persons so listed. In naming a jointly selected
26 or list of proposed candidates for special master, the parties
27 must comply with Rule 53(a)(2).

28 The parties shall, in their joint statement, include a

1 statement providing for the basis, terms, and procedure for
2 fixing the master's compensation as described in Rule 53(g). If
3 the parties cannot agree on the basis, terms, and procedure for
4 fixing the master's compensation, the joint statement shall
5 include each party's proposed compensation basis, terms, and
6 procedure.

7 The parties shall, in their joint statement, propose
8 any changes or modifications to special master's authority as
9 outlined in Rule 53(c) and duties that the court will outline
10 below. The parties shall recommend to the court the
11 circumstances, if any, in which the master may communicate ex
12 parte with the court or a party, and the nature of the materials
13 to be preserved and filed as a record of the master's activities.

14 B. Proposed Scope of Special Master Duties

15 After receiving the parties' joint statement, the court
16 will schedule a status conference to discuss, and agree upon, the
17 final form the Order appointing the Special Master shall take,
18 which shall include a statement of the scope of the Special
19 Master's duties. The court proposes that those duties include:

20 1. Determining the proper definition of one "of
21 ordinary skill in the art";

22 Viewing the patents from the perspective of a person of ordinary
23 skill in the art at the time of the invention,

24 2. Determining whether the term "video type signal"
25 as used in claims 19 and 25 of the '411 patent
26 constitute means-plus-function limitations;

27 3. If the special master finds that the term in (1)
28 does constitute means-plus-function limitations,

determining their functions and corresponding structures;

4. Determining the functions and corresponding structures for the terms "slicing means," "level detecting means," and "sync restoring means" as used in claim 6 of the '411 patent;
5. Determining and so construe any additional terms the parties agree should be construed as having a plain and ordinary meaning to one of skill in the art;
6. Determining any additional term constructions on which the parties agree;
7. Construing all disputed terms;
8. Identifying the functions and corresponding structures for the terms "circuit" and "circuitry" at issue in the '411 patent.

In their joint report, the parties may suggest any duties or suggest any modifications to the proposed duties of the Special Master outlined above.

At the conclusion of the status conference, the court will prepare and file an Order of appointment, which the parties shall serve on the Special Master along with copies of their claim construction briefs, replies, oppositions, and exhibits.

C. Further Proceedings

The Special Master shall proceed with all reasonable diligence in conducting a Markman hearing and preparing for the court a report recommending constructions for the patent terms at issue. The parties will be afforded an opportunity to file any

1 objections to the Special Master's report, and if the court finds
2 it helpful, oral argument on the objections may be scheduled.

3 The court will thereafter issue a final claim construction order.

4 IT IS SO ORDERED.

5 DATED: March 9, 2010

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8 WILLIAM B. SHUBB

9 UNITED STATES DISTRICT JUDGE

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